



Att. Docket 2-604.6-1
Serial No. 09/741,207

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

First named inventor: Barber, Timothy P.

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Title: Method for Secure, Closed Loop Money Transfer via
Electronic Mail

Group Art Unit: 3624

Examiner: Felten, Daniel S.

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SUPPLEMENTAL BRIEF FOR APPELLANTS

Sir:

This is a further supplemental brief in response to an Office action mailed Sept. 21, 2004, reopening prosecution, and offering applicant the option of either filing a reply under 37 SCR 1.111, or reinstating the appeal. Applicant respectfully hereby exercises the option of reinstating the appeal.

This further supplemental appeal follows a replacement appeal for a first supplemental brief following an initial appeal from an Office action mailed June 18, 2003, made final, in response to which a Notice of Appeal was filed on Aug. 15, 2003. This paper provides the supplemental appeal brief required by 37 CFR 1.193(b)(2) when reinstating an appeal, and is being filed within the one-month period following the three-month period for response to the Office action mailed Sept. 21, 2004. A petition for a one-month extension of time is included.

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I. THE REAL PARTY IN INTEREST

The real party in interest continues to be Timothy P. Barber, Ph.D., the party named in the caption of the brief.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-8 are pending, and as of the Office action mailed Sept. 21, 2004, continue to stand rejected, and are still being appealed.

IV. STATUS OF AMENDMENTS

No amendments are outstanding.

V. SUMMARY OF THE INVENTION

The invention is a method by which an e-mail recipient is rewarded for reading an e-mail. The intended use of the method is to make it more likely that if a sender sends an advertisement to a recipient by e-mail, the recipient will at least click on the e-mail and so possibly see the advertisement. See page 2, lines 5-9, and also page 3, line 18. According to the method, this is done by offering a reward to the recipient. The reward is money. The money, or more accurately, the promise of money, is conveyed as what in the application and claims is called a *stamp* (Fig. 4), which is included in the e-mail as an attachment.

The recipient need only redeem the stamp (step 6, Fig. 1; Fig. 2B) with an entity established for that purpose--typically, but not necessarily, the same entity as issued the stamp--and must do so within a time limit indicated (at least in part) by a value called the lifespan. See page 3, lines 14-16, and also page 4, lines 18-25. See also page 2, ll. 23-25.

The stamp is set out in the application (introduced at page 5, lines 3-18, and described in detail, in connection with Fig. 4, beginning at page 7, line 16, and continuing to page 9, line 19) and recited in the claims--and in particular claim 1--as being a concatenation of various fields, some of which are (cryptographic) hashes of fields, with the result that the stamp is tamper-proof.

(See page 2, ll. 19-25.) Also, the stamp indicates a value on its face called a face value (the amount the recipient would be rewarded if the recipient sends the stamp to the redeeming entity) as well as the above-mentioned time limit (either as a single value called the lifespan (which would then be a date and possibly a time), or in terms of two values: a lifespan (which would here be a period of time) and an issue time (a date and time). (See page 2, ll. 23-25 for a teaching of using at least (and thus possibly only) a lifespan, and see page 7, ll. 23-25, for a teaching of using both a lifespan value and an issue time value to indicate the time limit.) Thus, the recipient sees the amount of the reward, and how much time is left to claim the reward, but cannot change the amount of reward or the time left since the redeeming entity can detect any tampering based on the hashed fields included as part of the stamp.

It should be understood that the invention is not ever claimed merely as a data object/ stamp, but instead always as a method including--as recited in claim 1--at least the following steps (tracking the data flows 4-6 indicated in Fig. 1 and various of the steps shown in Figs. 2A and 2B):

- a) a stamp issuer providing to a sender a stamp (Fig. 1, step 4) having a face value and a lifespan both indicated on the stamp (page 6, line 5), the stamp being a string that is a concatenation of two or more fields including the face value (page 7, line 26) and the lifespan (page 7, line 23), with at least one of the fields (not the face value or the lifespan, i.e. one of the other fields) calculated according to a prescription

involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp (page 8, line 4);

b) the sender affixing the stamp to an e-mail and sending the e-mail to a recipient (Fig. 1, step 5; and page 6, line 26); and

c) the recipient of the e-mail redeeming the stamp (Fig. 1, step 6) for the face value by presenting the stamp to a predetermined entity (page 11, lines 3-8 and line 26).

Claims 2-7 are directed to different embodiments of the invention in respect to a stamp according to the invention (Fig. 4). Claim 8 is used to make clear that the entity that redeems such a stamp may or may not be the same as the stamp issuer.

VI. ISSUE

The following issue will be addressed in the argument:

Whether the Office action mailed Sept. 21, 2004 (hereinafter the Office action) erred in rejecting claims 1-8 under 35 USC section 112, second paragraph.

Whether the Office action erred in rejecting claims 1-8 under 35 USC section 103 as being unpatentable over Kuzma (U.S. Pat. No. 5,771,289) in view of Sundsted (U.S. Pat. No. 5,999,967).

VII. GROUPING OF THE CLAIMS

With respect to the rejection of under 35 USC section 112, second paragraph, all claims are involved, namely claims 1-8, and only the rejections of claim 1 and 2 are argued, and claims 3-8 are to stand or fall with claim 1.

With respect to the rejection of under 35 USC section 103, all claims are involved, namely claims 1-8, and (only) the rejection of claim 1 is argued, and claims 2-8 are to stand or fall with claim 1.

VIII. ARGUMENT

A. ERROR IN REJECTIONS OF CLAIM 1 AND CLAIM 2 UNDER 35 USC SECTION 112,
SECOND PARAGRAPH

At paragraph 4 of the Office action, claims 1 and 2 are rejected under 35 USC section 112, second paragraph. In asserting the rejection, the Examiner writes:

What is the difference between the issue time and the lifespan? Is the lifespan an indication of the electronic stamp up to the present time or is it an indicator of a (sic) expiration/cancellation date?

Claim 1 uses the term "lifespan" (but not the term "issue time") and claim 2 uses the term "issue time" and depends from claim 1, and so also uses the term "lifespan."

Applicant respectfully submits that claim 1 itself makes clear that the lifespan must be what the Examiner calls an indicator of an expiration/ cancellation date, since claim 1 recites:

wherein the predetermined entity provides the face value to the recipient only if the stamp is presented to the predetermined entity within the lifespan indicated on the stamp.

Thus, the lifespan must indicate (either alone, on some embodiments, or in combination with an issue time) a point in time when the stamp is no longer redeemable. If the lifespan were what the Examiner refers to as an "indication of the electronic stamp up to the present time," which applicant understands to mean the age of the stamp, then the stamp would be redeemable at any time, as long as it is still in existence. There would be no point in indicating such a "lifespan" on the stamp. Thus, the "lifespan" logically can only be an indicator of a point in time when the stamp is no longer redeemable. This is consistent with the application at page 6, line 5, which explains that a stamp, according to the invention, is issued "for

a specified lifespan," i.e. so as to be no longer redeemable after the point in time indicated by the lifespan.

The point in time may be indicated by the lifespan itself, e.g. a particular date and time (after which the stamp cannot be redeemed), or by the lifespan in conjunction with the issue time, e.g. the lifespan is one month, and the issue time is a date and time, and so the stamp cannot be redeemed one month after the issue time. See page 7, ll. 23-24. Claim 2 uses the term issue time, and applicant respectfully submits that the issue time for a stamp is clearly an indicator of a point in time when the stamp was issued, and per page 7, ll. 23-24, is used (in some embodiments) in combination with a lifespan to determine whether the stamp is still redeemable.

Applicant respectfully further submits that the (non-final) Office action in response to which this supplemental appeal brief is filed follows two other non-final rejections and a final rejection, in none of which is there an objection raised or a rejection made to the claims in respect to the uncertainty regarding the terms "issue time" and/ or "lifespan." Applicant respectfully therefore submits that the Office has already conceded that there is no failure in claiming in respect to the use of these terms.

For the foregoing reasons, applicant respectfully submits that the rejections of claims 1 and 2 under 35 USC §112, second paragraph, are error.

B. ERROR IN REJECTION OF CLAIM 1 UNDER 35 USC SECTION 103

At paragraph 6 of the Office action, claim 1 is rejected under 35 USC §103(a) as being unpatentable over Kuzma (U.S. Pat. No. 5,771,289) in view of Sundsted (U.S. Pat. No. 5,999,967).

In the rejection, the Office action asserts that Kuzma discloses a method of providing for a money transfer over a network, citing col. 1, ll. 15-25.

Electronic data transmission is known. For example, it is known that remote devices, such as computers and telefax machines can transmit and receive data over telecommunications networks. Such networks can be standard telephone lines, satellite transmission paths, digital microwave radio links, optical fibers or digital data transmission lines. They include local or wide area configurations. The communication channels can be provided by the owners of the network but more typically are leased from a common carrier, i.e. the telephone company. A modern network may consist of thousands of computing devices made by various manufacturers connected by a variety of transmission media spanning international and intercontinental boundaries.

Data transmission often is in the form of what is known as electronic mail. Electronic mail may be transmitted by means of point-to-point systems or computer based message systems.

Point-to-point systems link two specific terminals together for the duration of the transmission, and include telegrams, mailgrams, TELEX, TWX, and telefax.

Applicant respectfully submits that there is simply no teaching or suggesting here of providing for a money transfer over a network. In fact, Kuzma discloses only a method (and corresponding equipment) by which payment is required for transmitting an electronic message, payment that is made as the messages are transmitted, using previously obtained electronic stamps or credits. This is one attack on stopping either spam and/ or junk electronic mail. It forces a sender to pay for each electronic mail piece. Claim 1, by contrast, adopts another strategy, less onerous in case of senders of electronic messages that would not be considered spam/ junk electronic mail. In the method recited in claim 1, a person sending an electronic message typically for advertising entices the addressee to open and read the advertising by indicating to the addressee that by so doing, the addressee can in effect be paid for doing so. All that the addressee need do is to redeem a stamp included with the

electronic message (claim 1 reciting a step in which the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity). Thus, with the invention, a sender of advertising would be less inclined to send an electronic message to too many addresses, since each addressee could redeem the stamp included with the message. At the same time, a sender of personal or non-advertising messages need not worry about having to pay for sending an electronic message.

Next in rejecting claim 1, the Office action asserts that at co. 2, ll. 66 to col. 3, ll. 16, Kuzma discloses a step of "providing a stamp having a face value and a lifespan both indicated on the stamp." The cited text is:

... The electronic stamp preferably is a data packet that when processed by the carrier or at the addressee location appears as a stamp-like graphic marking on the transmitted document. Substantially concurrently with application of the electronic stamp to the electronic data, the counter or database containing the data corresponding to the sender's amount of electronic stamps is debited in an amount equal to the value of the affixed electronic stamp to reflect the use of the electronic stamp to pay for the electronic transmission of the data or message.

Also preferably substantially concurrently with the transmission of the data, the electronic stamp or stamp is "canceled" to prevent its further, fraudulent use. The cancellation mark preferably shows that the carrier has received the letter and that the electronic stamp has been accepted for transmission of the data. The cancellation mark also can identify the date and time the data was sent.

Applicant concedes that since the stamp disclosed in Kuzma is a "stamp-like graphic," it likely would indicate a value, but the value would not be the "face value" recited in claim 1 since it is not a value for which the stamp can be redeemed. In other words, unlike the face value of claim 1, the value of a Kuzma stamp it is not a value as far as the recipient is concerned, but rather a cost paid by the sender to send the electronic message.

Further, Kuzma does not disclose a stamp indicating a lifespan,

using either of the two allegedly possible interpretations of "lifespan" suggested in the Office action, let alone the only interpretation a fair reading of claim 1 permits (an indicator, possibly used in conjunction with an issue time designator, of a point in time after which the stamp can no longer be redeemed). All that Kuzma discloses is some marking that the stamp has been "canceled."

Next in rejecting claim 1, the Office action asserts that in Figs. 4a-d, and at col. 5, ll. 47+, and col. 6, ll. 37-40, Kuzma discloses a stamp being a string that is a concatenation of two or more fields including the face value and the lifespan. Applicant respectfully submits that none of Figs. 4a-d indicate a face value or a lifespan as in claim 1, let alone a string that is a concatenation (a combining, one after the other, as is understood by anyone skilled in the art of digital equipment) of same, nor does the cited text teach or suggest that a stamp according to Kuzma indicates or in any way (as a concatenation or otherwise) provides a face value and/ or a lifespan. Instead, Kuzma discloses a stamp that is a packet of data "instructing the electronic post office 250 that electronic message 202 should be transmitted," possibly including a unique code for authenticating the stamp, and possibly a graphic indicating cancellation. There is simply no mention of a lifespan or a face value.

For the reasons given, then, applicant respectfully submits that the rejection of claim 1 under 35 USC §103 is error.

But further in respect to the error in rejecting claim 1, the Office action concedes that Kuzma fails to disclose allowing the recipient of an e-mail to obtain value for a stamp if the stamp is presented to a predetermined entity within the lifespan of the stamp. For such a teaching, the Office action relies on Sundsted, citing col. 7, ll. 1-40, and col. 9, ll. 45-60, and likening the "date field 42" of Sundsted to the lifespan recited in claim 1.

Sundsted discloses a method and apparatus for filtering electronic mail, based on the value of an electronic stamp included with the electronic mail, as explained in the abstract. Sundsted teaches at col. 7, ll. 8-9, that a recipient can (in some embodiments) bill the sender for the value of the stamp if the recipient "accepts the electronic mail."

Applicant respectfully submits that Sundsted nowhere teaches including in the electronic mail a stamp including an indication of a lifespan limiting the time a receiver of electronic mail including the stamp can redeem the stamp for an indicated face value, as recited in claim 1. At col. 7, ll. 9-15, Sundsted does disclose a "date field," which the Office action likens to the lifespan recited in claim 1, but the date field cannot be fairly likened to either of the two possible interpretations of "lifespan" suggested in the Office action, let alone the only interpretation consistent with the language of claim 1 (namely that a predetermined entity provides the face value to the recipient only if the stamp is presented to the predetermined entity within the lifespan indicated on the stamp). Sundsted explains at col. 7, line 9, that the "date field" 42 "holds the creation date of the electronic stamp," and nowhere teaches that the date field is in any way related to limiting the time for the recipient to bill the sender for the value of the stamp.

The use of a lifespan to limit the time for redeeming a stamp for value has at least two significant advantages. First, the sender liability is limited in time, instead of possibly increasing indefinitely. Because recipients might not redeem stamps until receiving enough stamps that it is worth the effort to redeem them, and since the stamps would likely each be for a quite small value so that it would take a while for the recipient to receive enough stamps to amount to a significant value, recipients would typically hold off redeeming stamps for a long time. A sender might therefore incur over time a large liability

because even though each individual recipient might have only a small value of stamps to redeem, there would typically be a large number of recipients, and the total liability could be then quite large. With a lifespan, a sender can know what the maximum potential liability is at any time by keeping track of each stamp mailed out until the time based on the lifespan is past.

Another advantage is that having a lifespan will prompt a receiver to look at the electronic message right away, instead of waiting, possibly until whatever is being advertised is no longer for sale, since the lifespan could be set to correspond to a period of time corresponding to what is being advertised. Thus, a sender would not end up paying a recipient to look at an email advertising a product no longer for sale.

Therefore, in addition to the grounds argued above (based on Kuzma not teaching either a face value or a lifespan) that the rejection of claim 1 is error, applicant also respectfully submits that the rejection of claim 1 under 35 USC §103 is error because neither Kuzma nor Sundsted teach or suggest the steps of the method of claim 1 in respect to the use of a stamp having a lifespan limiting the time for the stamp to be redeemed.

C. COROLLARIES OF THE PRECEDING ARGUMENTS

It has been argued above that there was error in rejecting claim 1 under 35 USC §103. Accordingly, and as set out in the above grouping of the claims, it is here asserted that there was error in the rejections under 35 USC §103 of all the other claims remaining in the application, namely claims 2-8, since all of the other claims depend from claim 1, and stand (or fall) with claim 1.

IX. CONCLUSION

For all of the aforementioned reasons, it is respectfully submitted the rejections of all the claims in the application, namely claims 1-8, are error, and the rejections should be

reversed. Early allowance of all the claims in the application is earnestly solicited.

21 Jan. 2005

Date

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X. APPENDIX--THE CLAIMS INVOLVED IN THE APPEAL

1. (Previously presented) A method of providing for a money transfer over a network, comprising steps in which:

- a) a stamp issuer provides to a sender a stamp having a face value and a lifespan both indicated on the stamp, the stamp being a string that is a concatenation of two or more fields including the face value and the lifespan, with at least one of the fields calculated according to a prescription involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp;
- b) the sender affixes the stamp to an e-mail and sends the e-mail to a recipient; and
- c) the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity;

wherein the predetermined entity provides the face value to the recipient only if the stamp is presented to the predetermined entity within the lifespan indicated on the stamp.

2. (Original) A method as in claim 1, wherein the stamp is a concatenation of a set of fields, the set comprising:

- a) an issue time;
- b) a lifespan;
- c) a stamp value; and
- d) a first-hashed field that is a hash of a concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

3. (Original) A method as in claim 2, wherein the first-hashed field is a predetermined truncation of the output of the hash of

the concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

4. (Original) A method as in claim 2, wherein the set of fields of which the stamp is a concatenation further comprises a second-hashed field that is a hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

5. (Original) A method as in claim 4, wherein the second-hashed field is a predetermined truncation of the output of the hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

6. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a digitally signed encryption of the issue time field, the first-hashed field and the second-hashed field, wherein the encryption is performed using a private key of the stamp issuer.

7. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a pre-determined truncation of the issue time field, the first-hashed field, the second-hashed field, and a secret constant, known only to the stamp issuer and other qualified parties.

8. (Previously presented) A method as in claim 1, wherein the predetermined entity is the stamp issuer.